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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/432,523	11/03/1999	JOEL DONALD GRAY	100344-005-	1168	
7590	07/30/2004	EXAMINER			
ISABELLA, DAVID J					
ART UNIT	PAPER NUMBER			3738	

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/432,523	GRAY ET AL.	
Examiner	Art Unit		
DAVID J ISABELLA	3738		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 24 May 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 37-39, 41-43 and 45-54 is/are pending in the application.  
4a) Of the above claim(s) 43 and 45-54 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 37-39 and 42 is/are rejected.

7)  Claim(s) 41 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

***Status of the Claims***

Claims 37-39, 41 and 42 are directed to the elected invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37, 38,42 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Malecki et al (5626607).

Malecki et al discloses a surgical clamp (600) comprising:

An elongate one-piece, malleable hollow shaft (681) including a distal end (682) and a proximal end (688);

a tissue clamp assembly (602) including first and second movable opposable jaws (620,622) mounted at the distal end (682) adapted to grasp, secure and occlude body tissue and conduits (see column 23, lines 15-25);

a handle assembly (604) including first and second movable arms (see handle embodiment in figures 3, 10A, 17 and 31A and column 22, lines 45+) mounted at the proximal end; and an elongate actuator (606) disposed within the hollow shaft (681) including a first end (618) operatively connected to the tissue clamp assembly and a second end (670) operatively connected to the handle assembly such that when the

handle arms are moved from a first relative position to a second relative position, the first and second jaws of the tissue clamp assembly are moved between an open spaced apart position and a closed tissue gripping position or vice versa.

Claim 38, the tube of the shaft is metal.

Claim 42, the shaft is capable of being placed in different curvatures (see column 23, lines 20+).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malecki et al as applied to claim 37 above, and further in view of Swanson (6212426).

Malecki et al discloses a surgical clamp including an elongate one piece a malleable hollow shaft. Swanson teaches flexible probes made from materials such that the body may be malleable to be formed into a determined shape. The body is made from bendable wires/ribbons including stainless steel that are helically wound to form the flexible body. Instead of the malleable tubing forming the shaft of the clamp of

Malecki et al, one with ordinary skill in the art could form the shaft with a helical winding of stainless steel wire/ribbons since the windings offers the artistian more flexibility in tailoring the amount of malleable characteristics to the shaft.

***Allowable Subject Matter***

Claim 41 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 5/24/2004 have been fully considered but they are not persuasive. Contrary to applicant's arguments, Malecki et al does disclose the present invention as claimed. Applicant argues that the invention as claimed is not directed to additional and separate elements. The claims as worded do not support applicant's point for distinction. Malecki et al discloses an elongate one piece malleable hollow shaft (680). This shaft in combination with the tissue clamp (602), the handle assembly (figures 3, 10A, 17 and 31A and column 22, lines 45+) and the elongate actuator (608) anticipates the invention as claimed.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

GADBERRY ET AL                    6461363

WILK                                5395367

McMAHON ET AL                    5467763

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J ISABELLA whose telephone number is 703-308-3060. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID J ISABELLA  
Primary Examiner  
Art Unit 3738

DJI  
July 27, 2004